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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,501

09/08/2005

Mats Selin

14993NP

9240

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EXAMINER

CAMPANELLO, FRANCIS C

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

08/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,501	Applicant(s) SELIN, MATS	
	Examiner FRANK C. CAMPANELL	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/09/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim1 is objected to because of the following informalities: The word “homogene” should be “homogeneous”. The phrase “the solution being used as and additive to the actual liquid” should be “the solution being used as an additive to the actual liquid”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding claim1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

4. Claim 4 provides for the use of a solution, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim4 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

5.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Andress et al (US 5033415).

8. Regarding claims, 1-2, and 5, Andress teaches a method for making a lubricating solution used as an additive to a lubricant (column 2 lines 59-60). The additive is used to reduce friction (column 1 lines 17-21). It is inherent that such an additive would also have corrosion inhibiting properties. In the alternative, it would have been obvious to one of ordinary skill of the art at the time of the invention that such a composition would also contain corrosion inhibiting properties. The additive contains boric acid brought into a purely alcohol solvent. The boric acid is placed under heat and mechanical stirring. (column 3 lines 44-50). It is inherent that this solution would reach a homogeneous state after stirring. In the alternative, it would have been obvious to one of ordinary skill of the art at the time of the invention that such a solution after heating and mixing would reach a homogeneous state. This additive is used in fuels. (column 3 lines 29-35)

9. Regarding claims 3, the additive includes having more than 250,000 ppm borate concentration in the solution. In the alternative the amount of borate used would be as

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close to 250,000 ppm as to make no real difference as to the function of the invention.

See column 4 lines 8-15 and column 3 lines 44-50.

10. Claims 1-3, and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blecker et al (US 4539126)

11. Regarding claims, 1-2, and 5, Blecker teaches a method for making a lubricating solution used as an additive to a lubricant (column 1 lines 1-15). The additive is used to reduce friction and has corrosion inhibiting properties (abstract, column 1, lines 1-15).

The additive contains boric acid (column 4 lines 15-25). The solvent may be purely an alcohol solvent. (column 1, lines 50-55). The boric acid is placed under heat and mechanical stirring. (column 4 lines 15-25). It is inherent that this solution would reach

a homogeneous state after stirring. In the alternative, it would have been obvious to one of ordinary skill of the art at the time of the invention that such a solution after heating and mixing would reach a homogeneous state. This additive is used in fuels.

(column 2 lines 15-20)

12. Regarding claim 3, the additive includes having more than 250,000 ppm borate concentration in the solution. In the alternative the amount of borate used would be as close to 250,000 ppm as to make no real difference as to the function of the invention.

See column 4 lines 15-25.

13.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andress et al (US 5033415).

Regarding claim 4, the use of a boric compound in the range of 10 to 1,000 ppm is not specifically stated in Andress, but a range which would obviously include those amount is stated. See column 2 lines 60-65.

17. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blecker et al (US 4539126)

18. Regarding claim 4, the use of a boric compound in the range of 10 to 1,000 ppm is not specifically stated in Andress, but a range which would obviously include those amount is stated. See column 2 lines 15-20.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK C. CAMPANELLO whose telephone number is (571)270-3165. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FCC

/Walter D. Griffin/
Supervisory Patent Examiner, Art Unit 1797